

REMARKS

This communication responds to the Office Action of September 3, 2008, which was made final and in which claims 40-41, 43, and 45-48 were rejected under 35 U.S.C. §§ 102 and 103.

By this response, claim 40 is amended. Claims 1-12, 42 and 44 were previously canceled and claims 13-39 were previously withdrawn.

Entry, reconsideration and allowance are requested.

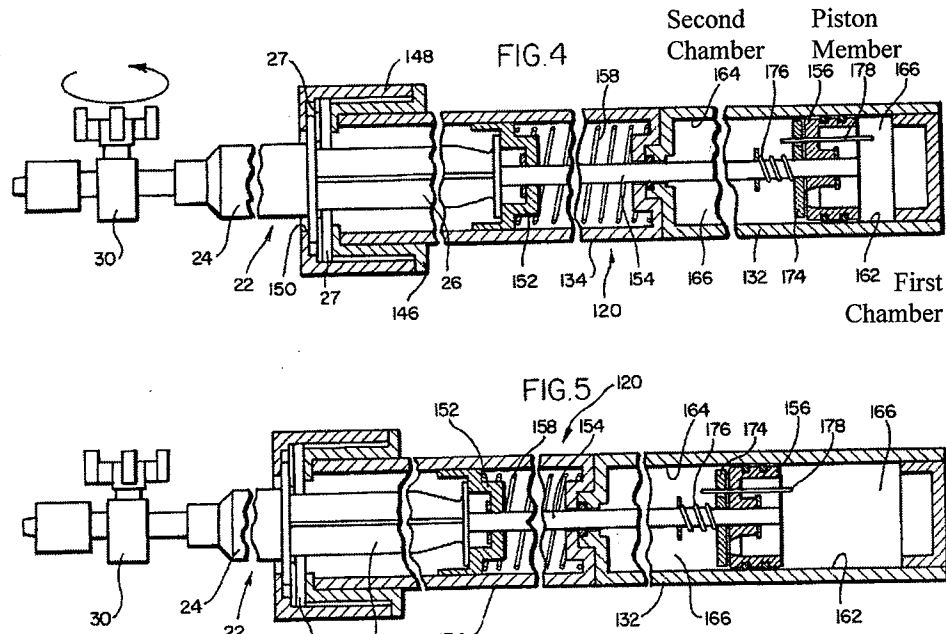
Claims 40, 41, 43, and 46-48 are not anticipated by Young

Claims 40, 41, 43 and 46-48 were rejected under 35 U.S.C. § 102(b) over U.S. Patent 5,788,673 ("Young"). The § 102 rejections are traversed for at least the following reasons.

The Examiner's rejection of claim 40 is improper. The Examiner misinterprets Young by focusing on Figure 2 of Young for providing a fluid infusion pump capable of delivering an injectable substance. In Young, "FIG. 2 is a cross-sectional view of the first embodiment of the fluid infusion pump device *without* a syringe engaged therewith." (Young, column 3, lines 29-31, emphasis added.). Clearly, when a syringe is not engaged with the fluid infusion pump in Young, an injectable product cannot be administered and does not anticipate claim 40. Nonetheless, the Examiner uses Figure 2 as a primary basis for rejecting claim 40.

In fact, Figures 4 and 5 depict a combination fluid infusion pump and syringe. "FIG. 4 is a cross-sectional view of the first embodiment of the fluid pump device with a syringe engaged therewith and in a fully cocked or [injection] *ready* position ; FIG. 5 is a cross-sectional view of the first embodiment of the fluid feed device with the syringe engaged therewith and in a partially depressed or *expended* position." (Young, column 3, lines 35-40, emphasis added.)

Figures 4 and 5 of Young are reproduced below for purposes of illustration.



In Young, the first chamber 162 and second chamber 164 are in fluid communication, and “fluid medium 166 can pass from the second chamber 164 to the first chamber 162 only through the metering orifice provided by the tube 178.” (*Young*, column 9, lines 4-6 and Figs. 4-5.) This change in volumes in Young is opposite to the claimed invention, which requires “decreasing the volume of the first volume, thereby causing the amount of fluid in the second volume to increase.” This fundamental difference between the present claims and Young means Young cannot be the basis for a rejection under § 102 because Young doesn’t disclose each and every element of the claims.

Young does not disclose “the first volume is decreased by urging a first piston against the first volume” as recited in claim 40. Rather, “the piston member 156 [] move[s] forwardly relative to the cylinder 132 and pressurize[s] the fluid medium 166 forward of the piston member 156” (*Young*, column 8, line 67 – column 9, line 3 and Figs. 4-5), and the area “forward of the piston member 156” is the second chamber 164. As a result, the volume of the second chamber 164 is decreased by the piston member 156, *not* the “first volume.”

Young does not disclose that “increasing second volume causes the second volume to exert a compression force on a second piston that drives the second piston, which causes the administration of injectable product from the reservoir” The second fluid chamber 164 does not exert a compression force on a second piston that drives the second piston. The only piston associated with second fluid chamber 164 is piston member 156, and piston member 156 is not driven by the fluid 166 in second fluid chamber but instead pressurizes the fluid 166. Thus, the second fluid chamber 164 merely receives a pressurizing force from piston member 156 so that fluid medium 166 is forced through tube 178 into first fluid chamber 162. *See Young*, column 8, line 66 – column 9, line 22 and Figs. 4-5. As discussed in the response to the October 31, 2007 Office Action, the change in volumes in Young results in a damping effect, in contrast to what is claimed, i.e., “the increasing second volume causes the second volume to exert a compression force on a second piston that drives the second piston, which causes the administration of injectable product from the reservoir.”

There is no indication in Young that the disclosed fluid infusion system could or should be modified to reach the claimed invention. Even if the Examiner were to try to take the position of contradicting the disclosure and teaching of Young by reversing the volume components in a future action, i.e., likening the first chamber 162 to the “second volume” and the second chamber 164 to the “first volume,” this would not result in the claimed invention because the first chamber 162 passively receives fluid 166 from tube 178, but the increased fluid 166 in first chamber 162 does not exert a compression force on a piston and thus does not “cause[] the second volume to exert a compression force on a second piston that drives the second piston, which causes the administration of injectable product from the reservoir.”

For at least the reasons set forth above, Young does not disclose or suggest the invention as claimed, and reconsideration and withdrawal of the § 102 rejections are requested.

Claim 45 is not obvious over Young in view of Tountas

Claim 45 stands rejected under 35 U.S.C. 103(a) over Young in view of U.S. Patent 4,773,419 (Tountas). The § 103 rejection is traversed for at least the following reasons.

Claim 45 depends from claim 40. As discussed above, Young does not disclose or suggest the invention of claim 40 because Young does not disclose or suggest “decreasing the volume of the first volume, thereby causing the amount of fluid in the second volume to increase,” that “the first volume is decreased by urging a first piston against the first volume,” or that “the increasing [of the] second volume causes the second volume to exert a compression force on a second piston that drives the second piston, which causes the administration of injectable product from the reservoir.”

Tountas discloses a device for applying a circumferential pressure to an extremity that includes a syringe pump 18 and a spring unit 20 that includes a compression spring to apply force to the plunger 24 of the syringe pump. (*Tountas*, Abstract.) Even assuming there would be a reason, and a benefit, to modify the Young fluid infusion system in accordance with Tountas, the resulting combination would not make the invention of claim 45 obvious because Tountas does not address the fundamental disclose deficiencies of Young as noted above with respect to claim 40. Accordingly, claim 45 is patentable for at least the reasons set forth above, and further in view of its additional recitations.*

Reconsideration and withdrawal of the § 103 rejection are respectfully requested.

*The same is true of the remaining dependent claims, claims 41, 43, and 46-48, which depend directly or indirectly from claim 40.

Conclusion

This response is being submitted on or before February 3, 2009, and an extension of the time to respond until that date is requested. The fee for the extension of time should be charged to Deposit Account No. 04-1420. It is believed that no additional fees are due in connection with this paper, but the Commissioner is authorized to charge any additional fees, including extension fees or other relief which may be required, or credit any overpayment and notify us of same, to Deposit Account No. 04-1420.

The application now stands in allowable form, and reconsideration and allowance are respectfully requested.

Respectfully submitted,

DORSEY & WHITNEY LLP
Customer Number 74307

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By:

David E. Bruhn
David E. Bruhn, Reg. No. 36,762
(612) 340-6317